REMARKS

Claim 2 is pending in the present application, claims 1 and 3-10 having been canceled. The Examiner rejected claim 2 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,799,055 (Peshkin, *et al.*). Applicant has added new claims 11-15. No new matter is introduced.

Applicant respectfully traverses this rejection.

Applicant urges that the Examiner has failed to make out a *prima facie* case of obviousness for these rejections. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the combination of prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

Peshkin is directed to a system and method for using 2 fluoroscope images to guide a surgical procedures. Specifically, Peshkin's written description discloses that the 2 images are an anterior/posterior (A/P) image and a sagittal image. Although Peshkin does acknowledge the importance of positioning the end point of the device (Col. 1, lines 25-30), as noted by the Examiner, Peshkin nowhere discloses a method for *positioning a biopsy needle from a given entry point on a patient to a given target,* as recited in claim 2. Peshkin discloses, *inter alia*, registering the A/P and sagittal images to the patient's body, displaying fiducials of one image on the other image, receiving user input to select an entry point on one image to define a virtual guidewire, and to receive user input to change a parameter characterizing the virtual guidewire.

For example, the section of Peshkin cited by the Examiner (Col. 7, line 24 to Col. 9, line 13) discloses selecting an entry point of a guidewire in the A/P image, moving the top and bottom points of the guidewire, correcting spatial distortions resulting from the fluoroscope optics, registering the A/P and sagittal images, and displaying points chosen on one image in the other image. Although Peshkin refers to an image and a second image in the "Aspects of the Invention" section, the only images discussed in the "Detailed Description of the Drawings" are the A/P and sagittal images. Furthermore, these are images based on body centered axes, not images *formed with said C-arm in said first position is formed in a first image plane* and *formed with said C-arm in said second position is formed in a second image plane*, as recited in claim 2. Peshkin also requires the use of fiducial markers of artifacts of known geometry to register the fluoroscopic images to the patient, which are not required by the method recited in Applicant's claim 2.

However, Peshkin fails to disclose or suggest a method for *positioning a biopsy needle from a given entry point on a patient to a given target,* that includes *positioning said C-arm in a desired first position, whereby an image formed with said C-arm in said first position is formed in a first image plane; . . .defining a first arbitrary plane including said given entry point; placing said needle at said given entry point; visually servoing said needle in said first arbitrary plane with respect to said location information in said first image plane to derive a first three-dimensional (3-D) needle position; defining a second arbitrary plane including said given entry point, different from said first arbitrary plane; placing said needle at said given entry point; visually servoing said needle in said second arbitrary plane with respect to said location information in said image plane to derive a second three-dimensional (3-D) needle position; determining a resulting plane defined by said first and second three-dimensional (3-D) needle positions; placing said needle at a selected point in said resulting plane at an arbitrary orientation; positioning said C-arm in a desired second position, whereby an image formed with said C-arm in said second position is formed in a second image plane; . . . and visually servoing said needle around said entry point in said resulting plane with respect to said location information in said second image plane, whereby said needle is at said entry point and aimed at said target,* as recited in Applicant's claim 2. The Examiner only generally refers to Peshkin as disclosing a method for positioning a biopsy needle substantially as claimed in claim 2, but does not otherwise provide any specific references to those features of Peshkin present in the method recited in Applicant's claim 2.

The Examiner concedes that Peshkin does not explicitly disclose storing location information of the targets, but contends it would be obvious to do so. However, as noted above, Peshkin fails to disclose any of the limitations of Applicant's claim 2. Thus, Applicant urges that claim 2 is not obvious over Peshkin. Reconsideration and withdrawal of these section 102 and 103 rejections are respectfully requested.

For the same reasons, Applicant urges that new independent claim 11, and its dependent claims 12-15, are not obvious over Peshkin.

CONCLUSION

Applicant urges that claim 2 and new claims 11-15 are in condition for allowance for at least the reasons stated. Early and favorable action on this case is respectfully requested.

Respectfully submitted,

By:

Michele L. Conover
Reg. No. 34,962
Attorney for Applicants

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SIEMENS CORPORATION
Intellectual Property Department, 5th Floor
170 Wood Avenue South
Iselin, New Jersey 08830
(732) 321-3100
(732) 321-3030 (FAX)